

08 MAY 2006



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Gordon & Rees, LLP
101 West Broadway, Suite 1600
San Diego, CA 92101

In re Application of :
VARKI et al. :
U.S. Application No.: 10/565,742 : DECISION ON PETITION
PCT No.: PCT/US04/22415 : UNDER 37 CFR 1.137(a)
Int. Filing Date: 14 July 2004 :
Priority Date: 15 July 2003 :
Attorney Docket No.: XUCSD.TBA :
For: METHODS FOR DETECTING :
AND ANALYZING N- :
GLYCOLYNNLEURAMINIC ACID :
(NEU5GC) IN BIOLOGICAL :
MATERIALS :
:

This decision is issued in response to applicant's "Petition for Revival of an International for Patent Designating the U.S. Abandoned Unavoidably A under 37 CFR 1.137(a)" filed 23 January 2006.

BACKGROUND

On 14 July 2004, applicant filed international application PCT/US04/22415 which claimed a priority date of 15 July 2003. Pursuant to 37 CFR 1.495, the thirty-month period for paying the basic national fee in the United States expired at midnight on 15 January 2006.

On 23 January 2006, applicant filed a transmittal letter for entry into the national stage in the United States which was accompanied by, *inter alia*: the basic national fee, a copy of the international application; and the present petition under 37 CFR 1.137(a).

DISCUSSION

A grantable petition pursuant to 37 CFR 1.137(a) must be accompanied by: (1) the required reply, unless previously filed; (2) the requisite petition fee; (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and (4) any terminal disclaimer (and fee as set forth in 1.20(d)) required pursuant to 37 CFR 1.137(c). Applicant has satisfied Item (1), (2) and (4).

With regard to Item (3), Section 711.03(c) of the Manual of Patent Examining Procedure states: "A delay resulting from an error (e.g., a docketing error) on the part of an

employee in the performance of a clerical function may provide the basis for a showing of "unavoidable" delay, provided it is shown that: (A) the error was the cause of the delay at issue; (B) there was in place a business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance; and (C) the employee was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such employee represented the exercise of due care."

Petitioner states that the above-identified application became abandoned as to the United States because of a docketing error. However, petitioner has not provided sufficient evidence that: (1) there was in place a business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance and (2) that the employee(s) was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such employee represented the exercise of due care.

In summary, the actions taken in the prosecution of this case do not reflect unavoidable delay. Specifically, unavoidable delay is present only where petitioner and those acting for petitioner take all actions necessary to continue the prosecution of an application, but through the intervention of unforeseen circumstances, a required action is not timely taken. The actions and circumstances described in this petition do not reflect the "care or diligence that is generally used and observed by prudent and careful men in relation to their most important business." Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887).

Therefore, applicant has not satisfied item (3) above.

Since applicant has not met the requirements for revival of an application under 37 CFR 1.137(a), revival under this section would not be proper.

RECOMMENDATION

Applicants may wish to consider filing a petition to the Commissioner under 37 CFR 1.137(b) requesting that the application be revived. Any petition filed under 37 CFR 1.137(b) requesting that the application be revived must meet the criteria indicated in 37 CFR 1.137. This recommendation to file a petition under 37 CFR 1.137(b) should not be construed as an indication as to whether or not any such petition(s) will be favorably considered.

CONCLUSION

The petition under 37 CFR 1.137(a) is DISMISSED without prejudice and the application remains **ABANDONED**.

If reconsideration on the merits of this petition is desired, an appropriate response to this decision must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.137(a)." Extensions of time may be obtained under 37 CFR 1.136(a).



Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Tel: (571) 272-3298
Fax: (571) 273-0459